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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)
Q182-US1

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name _____Application Number
10/798,499Filed
March 10, 2004First Named Inventor
Masias, Alvaro et al.Art Unit
2838Examiner
Edward H. Tso

Applicant requests review of the final rejection in the above-identified patent application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)☒ attorney or agent of record.
Registration number 42,491☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34. _____

Signature

Travis Dodd

Typed or printed name

818-833-2003

Telephone number

02/13/2007

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.

Submit multiple forms if more than one signature is required, see below*.

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This collection of information is required by 37 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

Alvaro Masias

Serial No.: 10/798,499

Filed: March 10, 2004

For: POWER SYSTEM FOR
MANAGING POWER FROM
MULTIPLE POWER SOURCES

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Examiner: Tso, Edward H.
Art Unit: 2838

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
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Pre-Appeal Brief Request for Review

This communication is submitted in response to the Final Office Action mailed on November 13, 2006 (the Office Action). The Applicant submits that a clear error has been committed in rejecting pending claims 1-28 as unpatentable over U.S. Patent number 5,874,786 (McVey). The error results from the failure of McVey to teach an energy management system having a primary battery and a secondary battery. Further, this error results in part from the Office Action arguing that a solar array panel is a battery.

REMARKS**Rejection of Independent Claims 1, 11, 16, and 22 Under 35 USC §102**

Claims 1, 11, 16 and 22 stand rejected under 35 USC §102 as being anticipated by U.S. Patent number 5,874,786 (McVey). Independent claims 1, 11, 16, and 22 are each related to a system for managing energy from primary batteries and secondary batteries. Claims 11, 16, and 22 each affirmatively claim a primary battery and a secondary battery. Claim 1 specifies an inlet ... adapted to detachably connect a primary battery” and an “inlet ... adapted to detachably connect a secondary battery.” Accordingly, the cited art must teach an energy management system having a primary battery and a secondary battery. As noted in paragraph 0004 of the specification primary batteries are distinguishable from secondary batteries in that they are designed to be recharged for many cycles.

McVey’s Solar Panels are Not the Claimed Batteries

McVey teaches a power system that uses solar arrays panels and batteries 22, 28, 36, and 42 (McVey batteries). The Office Action argues that the solar array panels serve as the batteries specified in the claims. As disclosed in MPEP §2111.01, when the specification defines the terms in a claim, the claim terms are limited to the definition in the specification. Paragraph 0004 of the specification defines the terms primary battery and secondary battery. In particular, paragraph 0004 specifies that “the term ‘primary battery’ refers to an electrochemical device” and “(t)he term ‘secondary battery’ refers to an electrochemical device.” Accordingly, the primary battery and the secondary battery specified in the claims are electrochemical devices. Electrochemical devices are called “electrochemical” because chemical reactions provide the energy that is converted to electrical energy. In contrast, McVey’s solar arrays “receive solar energy and provide, in response, electrical energy” as disclosed at C2, L57-58 and noted in the Abstract. Because McVey’s solar arrays use light as the energy source rather than chemical reactions, McVey’s solar array panels are not electrochemical devices and are accordingly cannot serve as the claimed batteries.

McVey’s solar array panels can be further distinguished from batteries. Batteries are employed to store energy as noted in paragraphs 19 and 45 of the disclosure. In fact, paragraph 25 refers to the batteries as energy storage devices. As noted above, McVey’s solar array panels “receive solar energy and provide, in response, electrical energy.” Since

electrical energy is provided in response to receiving electrical energy, these solar array panels do not provide electrical energy when not receiving solar energy. While this conclusion is supported by trying to use a solar powered calculator in the dark, it is also supported when McVey teaches that batteries 22, 28, 36, and 42 power the loads during the dark periods (C6, L59-64). These batteries power the loads during dark periods because the solar array panels are not producing electrical energy when not receiving solar energy. As a result, during dark periods, McVey takes advantage of the ability of batteries to store energy. Because the solar array panels do not have this ability to store energy, McVey switches from the solar array panels to the batteries in times of darkness (C6, L59-64). This same principle is employed in solar calculators with a battery backup. Since McVey's solar array panels do not have the energy storage capabilities associated with batteries, McVey's solar array panels are not batteries.

Since McVey's solar arrays are not available to serve as the claimed batteries, the McVey batteries 22, 28, 36, and 42 have to serve as the claimed batteries. As a result, the McVey batteries would have to include both primary batteries and secondary batteries. McVey does not teach that the McVey batteries include both primary batteries and secondary batteries. For this reason alone, the claims are not anticipated.

McVey Does Not Anticipate Claims 1, 11, 16, and 22 Even When the Argument That Solar Array Panels are Batteries is Accepted

Even if it is accepted that McVey's solar array panels are batteries, McVey still does not anticipate claims 1, 11 and 22. If the solar array panels are batteries, they would be secondary batteries since there is an argument that they are intended to "operate through many discharge/charge cycles" as described in paragraph [0004] of the specification. Even this argument is unusually weak since solar panels cannot be "recharged" like a secondary battery since they do not have the ability to store energy provided during a recharge. However, if the solar panels were secondary batteries, the McVey batteries 22, 28, 36, and 42 would have to include primary batteries in order to anticipate the claims. McVey provides no teaching that batteries 22, 28, 36, and 42 are primary batteries.

Since McVey provides no teaching that batteries 22, 28, 36, and 42 include primary batteries, the Office Action relies on inherency in arguing that these are primary batteries.

However, a proper inherency rejection requires that the McVey batteries are **necessarily** primary batteries in order to comply with MPEP §2212(IV). Because these batteries can be secondary batteries, batteries 22, 28, 36, and 42 are not necessarily primary batteries as required to support the inherency rejection. The Office Action actually supports the assertion that the batteries can be secondary batteries by stating that “it maybe deduce that the reference’s batteries **maybe** primary batteries” (sic). Since the Office Action needs to “deduce” this conclusion, it is clear that McVey does not teach that these batteries are primary batteries. Further, since the Office Action only argues that the McVey’s batteries “may be” primary batteries, the office action implicitly acknowledges that McVey’s batteries can be secondary batteries. Since the McVey batteries can be secondary batteries, the batteries are not necessarily primary batteries as is required for a proper inherency rejection. For this reason alone, McVey does not support an inherency rejection and the claims and not anticipated.

Conclusion

As noted above, McVey must teach both primary and secondary batteries. McVey teaches the use of solar arrays and batteries 22, 28, 36 and 42. However, the solar arrays are not batteries and McVey does not teach that batteries 22, 28, 36 and 42 include both primary and second batteries. For this reason alone, McVey does not anticipate claims 1, 11, 16, and 22. McVey does not even anticipate these claims when the argument that solar arrays are batteries is accepted. In this instance, the solar arrays would be secondary batteries. As a result, the McVey batteries would have to include primary batteries. McVey provides no such teaching. For this reason alone, McVey does not anticipate claims 1, 11, 16, and 22. While either of the above reasons alone shows that McVey does not anticipate these claims, the combination of these arguments provides an even stronger argument for the patentability of these claims.

Respectfully submitted



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